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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,092	09/17/2003	Philip C. Harris	884-030652	3718

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EXAMINER

LANGEL, WAYNE A

ART UNIT PAPER NUMBER

1754

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,092

Applicant(s)

HARRIS, PHILIP C.

Examiner

Wayne Langel

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 15-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 30-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-22-04</u> . | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- and 30-44*
- I. Claims 1-13^A drawn to a method of converting nitrogen dioxide to nitric oxide, classified in class 423, subclass 405.
 - II. Claims 15-29, drawn to a device for measuring NO , classified in class 422, subclass 83.

Claim 14 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 14. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or

(2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus, such as one which does not include the detailed limitations as recited in claims 15-29.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and vice versa, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Miles on January 11, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13 and 30-44. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-136244, which discloses the conversion of nitrogen dioxide to nitric oxide by passing a gas stream comprising nitrogen dioxide over yttrium-stabilized zirconia. (See the English Abstract.)

Claims 2 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62-136244. JP 62-136244 is relied upon as discussed hereinabove. The limitations recited in claims 2 and 5-10 would be matters of routine optimization or design choice. Accordingly such limitation would be prima facie obvious over JP 62-136244.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14 and 30-44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakagaki et al. No distinction is seen between the process and apparatus disclosed by Nakagaki et al, and that recited in claims 14 and 30-44. See especially Paragraphs [0008] to [0010]) The apparatus of Nakagaki et al would inherently include means for heating the surface of the material comprising yttrium-stabilized zirconia. In any event, it would be obvious to provide the apparatus of Nakagaki et al with such means, since Nakagaki et al teach in Paragraph [0007] that the NO_x - decomposing electrode measures NO at a high temperature from 700°C to 800°C . It would be obvious to heat the material so as to attain such high temperatures for the NO_x .

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagaki et al as applied to claims 14 and above, and further in view of JP 62-136244. It would be further obvious from JP 62-136244 to decompose nitrogen dioxide as the NO_x in the process of Nakagaki et al, since JP 62-136244 teaches that yttrium-stabilized zirconia will decompose nitrogen dioxide.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Szabo et al, who disclose the decomposition of nitrogen dioxide in the presence of YSZ.

Claims 2-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo et al. Szabo et al is relied upon as discussed hereinabove. The limitations recited in claims 2-11 would be matters of routine optimization or design choice. Accordingly these limitations would be prima facie obvious over Szabo et al.

Claims 14 and 30-35 and 38-44 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Szabo et al. Szabo et al is relied upon as discussed hereinabove. The apparatus of Szabo et al would inherently include means for heating the surface of the material comprising yttrium-stabilized zirconia. In any event, it would be obvious to provide the apparatus of Szabo et al with such means, since Szabo et al disclose in the Abstract that the temperatures should range from 500 to 700° C. It would be obvious to heat the material so as to attain such high temperatures for the NO_x,

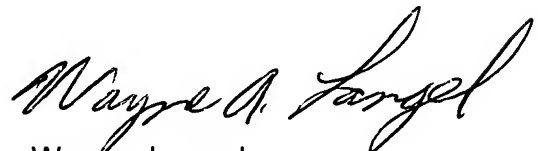
Claims 12, 13, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo et al as applied to claims 1-11 above, and further in

view of Nakagaki et al. It would be further obvious from Paragraph [0010] of Nakagaki et al to include other metal oxides in the YSZ of Szabo et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Langel whose telephone number is 571-272-1353. The examiner can normally be reached on Mondays to Fridays from 8 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wayne Langel
Primary Examiner
Art Unit 1754